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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/731,342 12/06/00 WIEGLAND

B JBP-529

EXAMINER

HM22/0802

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ART UNIT	PAPER NUMBER

1619

DATE MAILED:

08/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/731,342

Applicant(s)

WIEGLAND ET AL.

Examiner

Gina C Yu

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 is rejected because it refers to a non-existing claim, claim 21.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(A) Claim 1 is rejected under 35 U.S.C. §§ 102(a) as being anticipated by Herman. (Global Cosmetic Industry, vol. 162, n. 2, pp. 22 and 24).

Herman discloses that the basic components of a ringing gel formulations are oil, water, a surfactant, and a cosurfactant. See p. 22, 1st col., the paragraph bridging cols.1 and 2. See col. 2 penultimate paragraph where the surfactants are mixtures which reads on claim 1 (a). The oil phase reads on claim 1 (b), and carbomer is disclosed at last line of page 24 reads on (c).

Applicants specifically teach film forming polymer on one of the choices for benefit agents. See

spec. p. 12, line 12. Therefore carbomer meets the limitation of (c) as a film-forming polymer
absence of evidence to the contrary.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the
claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various
claims was commonly owned at the time any inventions covered therein were made absent any
evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out
the inventor and invention dates of each claim that was not commonly owned at the time a later
invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)
and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(A) Claims 2, 3, 10-17, 20 are rejected under 35 U.S.C. 103(a)
as being unpatentable over Herman as applied to claim 1 as above, and further in view of Santora
et al. (U.S. Pat. No. 6,046,145).

Herman is discussed above. The reference further teaches that multiple surfactants may
be used to render wide distribution of surface-active properties, with examples of using different
moles of ethoxylates. Using nonionic surfactant, polysorbate 20 to mix with fragrance oil, is also

Art Unit: 1619

disclosed. The reference lacks the teaching of using the amphoteric and anionic surfactants in claim 2.

Santora et al. teach a cleansing and moisturizing surfactant compositions comprising nonionic, amphoteric, and anionic surfactants in the amount of 5-20 % by weight and humectants in 0.01-3 % by weight, see col. 2, lines 14 – 32. Instant claims 10, 13-15 are met by this disclosure. The surfactants of claims 2 and 3 are disclosed in col. 3, line 22 – col. 5, line 12 and in col. 7, line 8 – col. 9, line 29. The surfactant system is said to provide mildness, non-greasiness, and non-irritating effects upon application to skin or hair, and provides good cleansing and moisturizing action. See col. 1, line 13 – col. 2, line 59. The mildness to eyes are especially emphasized. Addition of fragrance, coloring agents, and chelating agents is also disclosed, further meeting claim 10. The composition comprising water in the amount of 58.22 – 70.5 % by weight is disclosed, which meets claim 11. Claim 12 is also rejected because a skilled worker would have discovered the optimum or workable ranges by routine experiments.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Herman and add the surfactants and cosmetic actives of Santora et al. because of the expectation to have successfully produced a mild and non-greasy skin care composition which provides good cleansing and moisturizing effects.

(B) Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman and Santora et al. as applied to claims 1-3, 10-17, and 20 as above, and further in view of Greenberg et al. (U.S. Pat. No. 4,940,577).

Herman and Santora et al. are discussed above. The combined references lack the teaching of the limitations on oily phase as instant claims 4-8. Although Herman teaches that ringed gel requires oily phase and high level of surfactants, he fails to teach the amount of these components as required by instant claim 9.

Greenberg et al. teach a cosmetic composition comprising water-in-ester microemulsion with sunscreen additives and other cosmetic actives. About 2-15 % of emulsifiers and about 20-90% by weight of esters are used. See col. 2, lines 47 – 60. Greenberg et al. teach that a ringed gel composition requires 40-50% by weight of surfactants, col. 1, lines 13 - 16. For the oily phase, the esters including tridecyl stearate, tridecyl trimellitate, or neopentyl glycol dicaprylate/dicaprate, are disclosed, meeting claim 6. See col. 2, lines 31 – 43. Claims 4, 5, 7, 8 are also met because the HLB value and viscosity limitations of these claims are physical properties of the selected oils themselves. The reference teaches that the resulting composition is a clear microemulsion with a smooth and non-tacky feel. See col. 1, lines 13 – 61. For claim 9, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experiment.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references and used the esters as taught by Greenberg et al. because of the expectation to have produced a clear microemulsion skin care composition with a smooth and non-tacky feel.

(C) Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman as applied to claim 1 as above, and further in view of Piechota (U.S. Pat. No. 5,256,396).

Herman is discussed above. The reference lacks the teaching of using the composition to treat acne.

Piechota teaches topical ringing gel composition. He teaches that his invention is applicable to topical delivery of active ingrediets, including retinoids for acne treatment or antiseptic or antimicrobial agent. See col. 4, lines 28 – 43.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Herman's composition by adding retinoids or antimicrobial agents and used it to treat acne, as taught by Piechota, because of the expectation of successfully producing a ringing gel composition that may be used for acne treatment.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-305-3593. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Application/Control Number: 09/731,342

Page 7

Art Unit: 1619

Gina C. Yu
Patent Examiner
July 30, 2001

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